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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,459	09/13/2000	Morikatsu Matsuda	000004.000661	2151

7590 12/18/2001

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EXAMINER

GOODMAN, CHARLES

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/661,459

Applicant(s)

MATSUDA ET AL.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. The Supplemental Amendment filed on October 17, 2001 has been entered.

#### ***Continued Examination Under 37 CFR 1.114***

2. The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on [1] is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000. *See Changes to Application Examination and Provisional Application Practice*, interim rule, 65 *Fed. Reg.* 14865, 14872 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47, 52 (Apr. 11, 2000). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114. *See id.* at 14866, 1233 *Off. Gaz. Pat. Office* at 48.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- i. Claim 14 is vague and indefinite in that it is not clear what the claim encompasses. First in l. 2, the phrase "first claim" is not clearly understood. There is no "first" claim, i.e. claim 1, to refer back to. It appears that the phrase should perhaps read -- first clamp --. Second in l. 5, the phrase "the first clamp" lacks clear antecedent basis. Third, it is not clear how the first clamp can be moved to approach the second clamp in the second direction when claim 10 sets forth that there is no positioning via the positioning devices of which the clamps are parts thereof in the second direction. If there is no movement in the second direction, then what is the claim referring to? Substantially the same applies to the rest of the claims.

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claim 10 are 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn.

Dunn discloses a linear punch press comprising all the elements claimed including, inter alia, a body frame 20, 22, 30; a table 78; a first positioning device 86, 106, 106a for positioning a work piece in a first direction, wherein the first positioning device includes a first clamp (e.g., 106, Fig. 10) to clamp a first margin of the work pieces and a second clamp (e.g., 106a, Fig. 10) to clamp a second margin opposite to the first margin of the work piece, wherein the first clamp can be moved to approach the

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second clamp (see e.g. Fig. 10 and c. 3, ll. 53-59 which clearly shows the clamps 106 and 106a with either one adjustably slidably approaching each other); a second positioning device 86, 106, 106a (see Fig. 2) for positioning the work piece in the first direction; a working head 22 positionable in a second direction perpendicular to the first, wherein the positioning devices are arranged in series. See Figs. 1-13, c. 2, l. 31 - c. 5, l. 51.

### ***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Graf et al.

Dunn discloses the invention substantially as claimed except for the work piece being a material uncoiled from a coiled material. However, although Dunn is silent as to the sheet work piece being from coiled material, it is old and well known in the art to utilize the device and method of Dunn for punching sheet material uncoiled from a

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coiled material as evidenced by Graf et al. Graf et al clearly teaches a punching device and method wherein positioning devices 80, 105 are used to clamp and feed sheet shaped material uncoiled from a coiled material to a punching station 1 (see Fig. 1) for the inherent advantage of machine processing economy, i.e. less down time caused by intermittent feeding of discontinuous work piece sheets, that a longer continuous work piece material affords. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device and method of Dunn with the coiled material as taught by Graf et al for the reasons stated *supra*.

Alternatively, the coiled material has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, with respect to the apparatus claims, the claimed "coiled material" fails to further limit the structure of the invention to the extent necessary for any significant patentable consideration since the work piece itself does not define any *structure*. The claims also lack any specific structural detail that is distinctive for the "coiled material." Thus, for all the foregoing reasons, it is not subject to significant patentable weight.

10. Claims 10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kindgren et al in view of Dunn.

Kindgren et al discloses the invention substantially as claimed except for the first positioning mechanism having a second clamp. However, Dunn teaches positioning devices 86, 106, 106a wherein each device has a plurality of clamps 106, 106a which

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clamp two side margins of a work piece for the purpose of providing a more secure positioning of the work piece. Moreover, either one of the clamps are approachable to each other to adjust for various widths work pieces. See Figs. 1, 2, 4, and 10, c. 4, l. 49 - c. 6, l. 51. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Kindgren et al with the plurality of clamps as taught by Dunn in order to facilitate enhanced engagement of work pieces of varying sizes for positioning.

11. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kindgren et al in view of Dunn as applied to claims 10 and 14-16 above, and further in view of Graf et al.

The modified device and method of Kindgren et al discloses the invention substantially as claimed except for the work piece being a material uncoiled from a coiled material. However, although Kindgren et al, modified, is silent as to the sheet work piece being from coiled material, it is old and well known in the art to utilize the device and method of Kindgren et al for punching sheet material uncoiled from a coiled material as evidenced by Graf et al. Graf et al clearly teaches a punching device and method wherein positioning devices 80, 105 are used to clamp and feed sheet shaped material uncoiled from a coiled material to a punching station 1 (see Fig. 1) for the inherent advantage of machine processing economy, i.e. less down time caused by intermittent feeding of discontinuous work piece sheets, that a longer continuous work piece material affords. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device and method of

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Kindgren et al with the coiled material as taught by Graf et al for the reasons stated *supra*.

Alternatively, the coiled material has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, with respect to the apparatus claims, the claimed "coiled material" fails to further limit the structure of the invention to the extent necessary for any significant patentable consideration since the work piece itself does not define any *structure*. The claims also lack any specific structural detail that is distinctive for the "coiled material." Thus, for all the foregoing reasons, it is not subject to significant patentable weight.

### ***Response to Arguments***

12. Applicant's arguments filed October 17, 2001 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Dunn does not anticipate the claimed invention merely because Dunn may position in more than one direction,<sup>1</sup> this argument lacks merit. Although the positioning devices of Dunn allows for positioning in more than one direction, the positioning devices move in only the one direction through the punching head after the work is clamped. There is nothing in claim 10 that removes this teaching of Dunn from anticipating the claimed invention.



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In response to Applicant's basic argument that there is no suggestion to combine the references,<sup>2</sup> the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine stem from Graf et al. Graf et al clearly teaches a punching machine that facilitates punching of the web material from a coiled roll which clearly provides the advantage of relatively continuous punching operation due to the fact that the coiled material eliminates downtime associated with working on discrete sheets. Thus, it would have been obvious to the ordinary artisan at the time of the invention to modify Dunn with the teachings of Graf et al as noted in the rejection *supra*. Moreover, it is irrelevant whether Graf et al includes independently movable clamps since (1) this is not the feature relied on with respect to Graf et al and (2) the primary reference already includes this lacking feature. The same applies to the rest of Applicant's arguments regarding Graf et al.

In response to Applicant's basic argument that the combination of Kindgren et al and Dunn do not render obvious the claimed invention,<sup>3</sup> this argument lacks merit. Applicant's arguments are couched in the erroneous assertion that Kindgren et al does not position the workpiece during the punching operation. Where does Kindgren et al

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<sup>1</sup> Supplemental Amendment, Paper No. 10, p. 5, ll. 1-9.

<sup>2</sup> *Id.*, p. 5, ll. 10-16.

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specifically teach that the clamps do not position the workpiece during punching operation? Columns 3-4 of Kindgren et al clearly teaches that the clamps reposition the workpiece. This clearly includes repositioning during the punching operation. Moreover, repositioning of the workpiece during the punching operation is the common and well known manner in which these automated punching devices operate.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**allan.shoap@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality

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<sup>3</sup> *Id.*, p. 5, l. 17 - p. 6, l. 4.

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requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

cg *CS*  
December 17, 2001

*Charles Goodman*  
Charles Goodman  
Patent Examiner  
AU 3724